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10/054,503

01/22/2002

Charles M. LaMotta

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05/06/2005

EXAMINER

STEELMAN, MARY J

SPRINT COMMUNICATIONS COMPANY L.P.

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KSOPHT0101-Z2100

OVERLAND PARK, KS 66251-2100

ART UNIT

PAPER NUMBER

2191

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/054,503

Applicant(s)

LAMOTTA ET AL.

Examiner

Mary J. Steelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1/22/02, 5/3/02, 4/2/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-20 are pending.

#### ***Claim Objections***

2. Claim 7, line 2, recites "one ore more...", should be --one or more--. Delete the 'e' from ore.

#### ***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because:

FIG. 1, #100 is not in the drawing, #101d is not in the Specification.

FIG. 3, #52-PORT INTERFACE, should be #352.

FIG. 4, #490 is not in the drawing. See Specification page 24, line 1.

FIG. 30a, #3016, #3018 are missing in the Specification.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

#### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A

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replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Regarding claim 10, the phrase "of such a nature" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "of such a nature"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,182,275 B1 to Beelitz et al., in view of US Patent 6,853,978 B2 to Forth et al.

Per claims 1, 8, and 14:

A method / system / computer readable medium in a computing environment for determining compatibility of parts in a selected product configuration, the method comprising:

(Beelitz: Col. 2, lines 21-24, "presenting to a user a list of options compatible with a previous choice...for specifying software...and hardware...", col. 2, line 22, "system", col. 2, line 26, "method", col. 2, lines 41-42, "includes a software program installed thereon (computer readable medium)")

-determining whether a new part is compatible with one or more existing parts of the product configuration;

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(Beelitz: Col. 4, lines 51-54, "The control computer system then accesses the master data base to generate a second list of options (for a new part) wherein each option of the second list is compatible with the previous selection (compatible with existing parts).")

Beelitz only provided a list of compatible parts and failed to address:

-and if said new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and said new part.

Forth also disclosed configuring electronic devices to order. Forth disclosed (col. 12, lines 45-49), "A particular choice may be invalid where the specified type of model...is no longer manufactured or otherwise available, the chosen...is incompatible (not compatible with existing)...order processing interface automatically provides valid substitutions (determining a replacement part)..."

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz's invention for generating a compatible order of a computer system by suggesting a replacement part, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, "As the consumer or supplier updates or expands their operations, they must often order new or updated IED's (intelligent electronic devices) to either replace outdated or broken devices or to meet the needs..." Beelitz, col. 2, lines 15-26, "If the selected programs are incompatible, the program returns an error which requires the generation of a new file...presenting to a user a list of options

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compatible (implied alternate choices) with a previous choice made by a user advantageously enables a system for specifying software programs and hardware components for a computer system.” Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth explicitly providing a replacement part.

Per claims 2 and 15:

Beelitz failed to disclose:

-replacing said existing incompatible part with a compatible alternative existing part.

However Forth disclosed (col. 13, lines 40-47), “If an invalid configuration is determined, the order can be flagged and returned to the order processing system... a suitable substitution for the invalid configuration may be automatically provided (replace existing incompatible part with a compatible alternative existing part)...”

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz’s invention for generating a compatible order of a computer system by suggesting a replacement part, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, “As the consumer or supplier updates or expands their operations, they must often order new or updated IED’s (intelligent electronic devices) to either replace outdated or broken devices or to meet the needs...” Beelitz, col. 2, lines 15-26, “If the selected programs are incompatible, the program returns an error which requires the generation of a new file... presenting to a user a list of options

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compatible (implied alternate choices) with a previous choice made by a user advantageously enables a system for specifying software programs and hardware components for a computer system.” Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth explicitly suggesting replacing existing incompatible part with a compatible alternative existing part.

Per claims 3 and 16:

Beelitz failed to disclose:

-providing an alternative new part if a replacement part to said existing incompatible part is not available.

However Forth disclosed (col. 13, lines 44-47), “where an older model...is requested but no longer available (not available), the newer model may be automatically substituted (providing alternative new part if replacement part not available))...”

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz’s invention for generating a compatible order of a computer system by suggesting a replacement part, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, “As the consumer or supplier updates or expands their operations, they must often order new or updated IED’s (intelligent electronic devices) to either replace outdated or broken devices or to meet the needs...” Beelitz, col. 2, lines 15-26, “If the selected programs are incompatible, the program



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returns an error which requires the generation of a new file...presenting to a user a list of options compatible (implied alternate choices) with a previous choice made by a user advantageously enables a system for specifying software programs and hardware components for a computer system.” Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth explicitly providing an alternate new part.

Per claims 4 and 17:

-determining whether said new part is compatible with the product configuration.

(Beelitz: Col. 6, lines 14-17, “The control computer system reads tags to generate the list of options (system determines whether new part is compatible with product configuration) to be presented to the user interface that are compatible with a previous selection of selections.”)

Per claims 5 and 18:

-consulting a product table to determine whether said new part is compatible with the product configuration.

(Beelitz: Col. 5, lines 54-58, “the master data base (product table) is a computer system readable data base that includes an entry for every software program and hardware component option offered by a computer system manufacturer or vendor for a build-to-order computer system”, col. 6, lines 34-37, “...when the control computer system reads the tag (in a record of the master data base), it then knows to create a list of options for the particular entry if that entry is selected”, col. 6, lines 46-49, “...the tags would indicate what hardware components, software

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programs...are required...” Thus a master data base (product table) is consulted. Tags determine compatibility.)

Per claims 6 and 19:

Beelitz only supplied compatibility information. Beelitz failed to disclose:

-consulting a part incompatibility table to determine whether said new part is incompatible with one or more existing parts.

However, Forth disclosed determining incompatibility. Forth suggested, col. 14, line 67 – col. 15, line 11, “the order is validated to ensure that the requested configuration is manufacturable/ producible...device may no longer be manufactured or the hardware options or custom frameworks may be incompatible or outdated...the order processing interface may include an order validator designed to flag invalid configurations (by consulting a part incompatibility table). Forth suggested providing a mechanism to determine whether said new part is incompatible with one or more existing parts.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz’s invention for generating a compatible order of a computer system by suggesting a replacement part, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, “As the consumer or supplier updates or expands their operations, they must often order new or updated IED’s (intelligent electronic devices) to either replace outdated or broken devices or to meet the

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needs...” Beelitz, col. 2, lines 15-26, “If the selected programs are incompatible, the program returns an error which requires the generation of a new file...presenting to a user a list of options compatible (implied alternate choices) with a previous choice made by a user advantageously enables a system for specifying software programs and hardware components for a computer system.” Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth suggesting a determination of incompatibility.

Per claims 7 and 20:

Beelitz failed to disclose:

-determining whether said new part is incompatible with one or more base parts of the product configuration, wherein if said new part is incompatible with one or more base parts, an alternative new part is provided.

However Forth disclosed (col. 13, lines 40-47), “If an invalid configuration is determined, the order can be flagged and returned to the order processing system...a suitable substitution for the invalid configuration may be automatically provided (alternative new part provided)...”

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz’s invention for generating a compatible order of a computer system by suggesting a replacement part, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, “As the consumer or supplier updates or expands their operations, they must often order new or updated IED’s

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(intelligent electronic devices) to either replace outdated or broken devices or to meet the needs..." Beelitz, col. 2, lines 15-26, "If the selected programs are incompatible, the program returns an error which requires the generation of a new file...presenting to a user a list of options compatible (implied alternate choices) with a previous choice made by a user advantageously enables a system for specifying software programs and hardware components for a computer system." Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth explicitly providing an alternate new part to ensure compatibility with base parts.

Per claim 9:

A computer system capable of determining the compatibility of parts in a product configuration, the computer system comprising:

- a compatibility component which determines whether a selected part is compatible with existing parts of the configuration;

(Beelitz: Col. 4, lines 42-45, "control (compatibility component) accesses a master data base...to generate a list of options available...", col. 4, lines 51-54, The control computer system (compatibility component) then accesses the master data base to generate a second list of options wherein each options of the second list is compatible (determines selected part is compatible) with the previous selection....)

Beelitz failed to disclose:

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-a replacement component which determines replacement parts for one of existing part is and new parts if a determination of incompatibility is made.

However Forth disclosed configuration electronic devices to order. Forth disclosed (col. 12, lines 45-49), "A particular choice may be invalid where the specified type of model...is no longer manufactured or otherwise available, the chosen...is incompatible (determination of incompatibility)...order processing interface automatically provides valid substitutions (determining a replacement part)..."

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz's invention for generating a compatible order of a computer system by suggesting a replacement part, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, "As the consumer or supplier updates or expands their operations, they must often order new or updated IED's (intelligent electronic devices) to either replace outdated or broken devices or to meet the needs..." Beelitz, col. 2, lines 15-26, "If the selected programs are incompatible, the program returns an error which requires the generation of a new file...presenting to a user a list of options compatible (implied alternate choices) with a previous choice made by a user advantageously enables a system for specifying software programs and hardware components for a computer system." Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth explicitly providing a replacement part in the case of incompatibility.

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Per claim 10:

-a part determination component which determines whether a selected part is of such a nature to be added as a part.

(Beelitz: Col. 6, lines 8-12, "Each entry in the master data base also includes at least one tag or tag field. A tag or tag field is an indication used to define a characteristic associated with a particular part number of a database entry. These tags (part determination component) are used to categorize each entry and to indicate compatibility (determines whether a selected part is of such a nature to be added as a part)...")

Per claim 11:

Beelitz disclosed referencing a table to ensure compatibility (col. 6, lines 8-12) but failed to disclose:

-compatibility component includes a part incompatibility table which indicates which parts are incompatible with one another.

However, Forth disclosed determining incompatibility. Forth suggested, col. 14, line 67 – col. 15, line 11, "the order is validated to ensure that the requested configuration is manufacturable/ producible...device may no longer be manufactured or the hardware options or custom frameworks may be incompatible or outdated...the order processing interface may include an order validator designed to flag invalid configurations (by consulting a part incompatibility table). Forth suggested that a mechanism is in place to check for part incompatibility.

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Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz's invention for generating a compatible order of a computer system by suggesting a determination of incompatibility, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, "As the consumer or supplier updates or expands their operations, they must often order new or updated IED's (intelligent electronic devices) to either replace outdated or broken devices or to meet the needs..." Beelitz, col. 2, lines 15-26, "If the selected programs are incompatible, the program returns an error which requires the generation of a new file...presenting to a user a list of options compatible (implied alternate choices) with a previous choice made by a user advantageously enables a system for specifying software programs and hardware components for a computer system." Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth suggesting a means for determination of incompatibility.

Per claim 12:

-said part determination component includes a product table for determining whether said selected part is one that can be added to said existing parts.

(Beelitz: Col. 5, line 66-col. 6, line 12, "Each entry in the master data base includes a manufacturer specific part number (product table) or identification field with each individual hardware components, software programs, or installation operations having a specific number...tags are used to categorize each entry and to indicate compatibility (determining whether said selected part is one that can be added)...")

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Per claim 13:

Beelitz failed to disclose 'incompatibility'. However Forth disclosed:

A computer readable medium containing a data structure for storing part incompatibility information, wherein the data structure comprises:

Forth: Col. 14, lines 16-23, "Within the Virtual Meter Web Site, the customer has the ability to select...configurations... The site is coupled with a master server which further includes the order management database. The server and database maintain all of the data related to current and previous orders as well as store configurations libraries (computer readable medium containing a data structure)..." Regarding 'incompatibility', Forth disclosed that an order is validated to ensure configuration (col. 14, line 67-col. 15, line 7) and flagged by an 'order invalidator' if invalid.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz's invention for generating a compatible order of a computer system by suggesting a determination of incompatibility, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, "As the consumer or supplier updates or expands their operations, they must often order new or updated IED's (intelligent electronic devices) to either replace outdated or broken devices or to meet the needs..." Beelitz, col. 2, lines 15-26, "If the selected programs are incompatible, the program returns an error which requires the generation of a new file...presenting to a user a list of options compatible (implied alternate choices) with a previous choice made by a user advantageously



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enables a system for specifying software programs and hardware components for a computer system.” Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth suggesting a means to invalidate an incompatible selection.

-a plurality of records in a table, each record including at least two product identification values...

(Beelitz: See FIG. 8A – shows part number , compatibility tag, and description field (product identification values).)

-said values representing that said products represented by said identification values are incompatible...

Beelitz failed to discuss ‘incompatibility’ issues and only presented ‘compatible’ options. However Forth suggested the detection of ‘incompatibility’ and presented alternative suggestions. Forth, col. 12, lines 47-56, “validation is a batch process which occurs once the customer has finished specifying...A particular choice may be invalid...order processing interface automatically provides valid substitutions...”

Beelitz failed to disclose:

-an indication as to product identification values which are suitable replacements for at least one of said product identification values entered in said record.

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However, Forth disclosed (col. 12, lines 47-56), "validation is a batch process which occurs once the customer has finished specifying...A particular choice may be invalid...order processing interface automatically provides valid substitutions (indicate suitable replacement)..."

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Beelitz's invention for generating a compatible order of a computer system by suggesting a determination of incompatibility, as suggested by Forth, because both inventions are directed towards selection of compatible components. Forth, col. 1, lines 63-66, "As the consumer or supplier updates or expands their operations, they must often order new or updated IED's (intelligent electronic devices) to either replace outdated or broken devices or to meet the needs..." Beelitz, col. 2, lines 15-26, "If the selected programs are incompatible, the program returns an error which requires the generation of a new file...presenting to a user a list of options compatible (implied alternate choices) with a previous choice made by a user advantageously enables a system for specifying software programs and hardware components for a computer system." Thus both inventions are directed towards conveniently providing the consumer with correct choices, with Forth suggesting a means to detect invalid choices and providing a suitable substitute.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

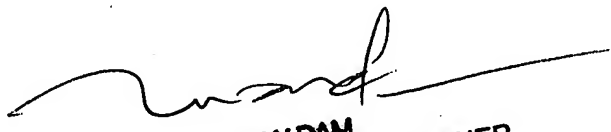
Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman



04/28/2005



**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**